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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/570,839

12/18/2006

Theodor Doll

3222.1430000

8784

26111

7590

03/06/2008

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

WAGNER, JENNY

ART UNIT

PAPER NUMBER

2891

MAIL DATE

DELIVERY MODE

03/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/570,839	<b>Applicant(s)</b> DOLL ET AL.	
	<b>Examiner</b> JENNY L. WAGNER	<b>Art Unit</b> 2891	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 2-22 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restriction***

Restriction is required under 35 U.S.C. 121 and 372:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, Applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Claims 2 and 5-7 are generic claims that will be examined with whichever invention Applicant elects.

I. Claims 3, 8-12 and 14-18, drawn to a method to produce electronic components with closely adjacent electrodes on a substrate, wherein the third metal layer is not in direct contact with the first and second metal layers. If Applicant elects this group, further election to one of the following sub-groups is required. Claims 14-18 are generic claims that will be examined with whichever sub-group Applicant elects.

IA. Claims 3 and 10-12, wherein the third metal layer is formed on the second photo lacquer layer.

IB. Claims 8 and 9, wherein the second photo lacquer layer is formed on the third metal layer.

II. Claims 4, 13 and 19-22, drawn to a method to produce electronic components with closely adjacent electrodes on a substrate, wherein the third metal layer is in direct contact with the first and second metal layers.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 12.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The inventions are categorized as follows:

Group I: forming closely adjacent electrodes by forming a first and a second electrode that are insulated from a third electrode.

Group IA: forming electrodes by forming the third electrode on a photo lacquer.

Group IB: forming electrodes by forming the photo lacquer on a third electrode.

Group II: forming closely adjacent electrodes by forming a first and a second electrode that is in direct contact with a third electrode.

The only recognizable common special technical feature between groups I and II is the result of the inventions, namely the structuring of electrodes by etching layers of photosensitive resist. However, this technical feature is well-known in the art.

The only recognizable common special technical feature between groups IA and IB is the resultant structure, namely that a third electrode is insulated from first and second electrodes. There is no evidence on the record that these are obvious over each other. However, this technical feature is well-known in the art.

The technical feature represented by the structuring of electrodes by etching layers of photosensitive resist is thus not novel and does not represent a contribution over the prior art. Therefore, the two inventions do not share a common inventive concept which could establish unity of invention under PCT Rule 13.1.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNY L. WAGNER whose telephone number is (571)272-9792. The examiner can normally be reached on Monday through Thursday 7:00 a.m. to 5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Baumeister can be reached on 571-272-1722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jenny L. Wagner  
Patent Examiner

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AU 2891

/David A. Zarneke/  
Primary Examiner, Art Unit 2891  
2/27/08